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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,957	07/14/2003	Mitsushi Yamamoto	UNI79.013AUS	6418
20995 7590 12/18/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
12/18/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary

Application No.

10/618,957

Applicant(s)

YAMAMOTO ET AL.

Examiner

VICTOR S. CHANG

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 10-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 13, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 10-12, 14, 15, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' amendments and remarks filed on 10/7/2008 have been entered. Claims 8 and 14 have been amended. Claim 18 has been cancelled. New claims 19 and 20 have been entered. Claims 8, 10-12, 14, 15, 19 and 20 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Specification

4. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: the specification throughout contains numerous words with incomplete spelling, e.g., page 7,

bottom paragraph. Appropriate corrections of the spelling errors throughout the specification are required in the next reply.

Rejections Based on Prior Art

5. Claims 8, 10-12, 14 and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by Masuda [US 20020064650A1].

Masuda's invention relates to a protective film for window application. The film comprises a polyester film having on at least one side thereof an antistatic coating. The antistatic coating has a specific surface resistance of not more than $1.0 \times 10^{13} \Omega$, and a haze of not more than 5.0% and a visible light transmittance of 3 to 70% (transparent) [0012]. Examples of the antistatic agents include polymers having a backbone containing repeating units of pyrrolidinium rings [0031]. A hard coat may be (optional) provided on the antistatic coating. The hard coat is a known type of heat-curing or ultraviolet-curing coating mainly comprising an acrylic or methacrylic acid derivative. The antistatic coating eliminates non-uniformity in the hard coat caused by static electricity pattern [0040]. On the side opposite from the hard coat of the polyester film, a known adhesive is applied for pasting the film on window glass [0044].

For claim 8, Masuda's teaching that the polyester film has on at least one side thereof an antistatic coating is interpreted that the antistatic coating is applied either on one side or both sides of the film. When the antistatic coating is applied only on side of the film, Masuda teaches a protective film of the same structure and composition as the claimed invention. Regarding the transparency after heat treatment, it is deemed to be inherent to the same chemistry. Regarding the use language in the preamble, since statements of intended use do not serve to distinguish

structure over the prior art, it has not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974).

For claims 10 and 11, Masuda teaches that the thickness of the adhesive layer is 15 microns [0099], which reads on the claimed range of 3-100 microns or 5-40 microns.

For claim 12, Masuda teaches that the polyester film comprises polyethylene terephthalate, etc. [0017].

For claim 14, the entirety of the film is deemed to be transparent, as evidenced by its use for window application.

6. Claim 19 is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Masuda [US 20020064650A1].

The teachings of Masuda are again relied upon as set forth above.

For claim 19, Masuda teaches that a known adhesive can be used, and exemplifies an adhesive composition comprising polyurethane and polyester resins [0102-0103]. The polyester resin is inherently formed from monomers containing carboxyl groups and hydroxyl groups. Regarding the weight percentages of the monomers, since Masuda teaches the same adhesive composition for the same end use as the claimed invention, workable amounts of monomers in the copolymer are deemed to be either anticipated, or obviously provided by practicing the invention of prior art for the same end use.

7. Claims 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art (APA) in view of Masuda [US 20020064650A1].

The teachings of Masuda are again relied upon as set forth above.

APA states in the Background section that two layered protective film for preventing adhesion of foreign matter or soil to a transparent conductive substrate is known [0004]. High polyethylene terephthalate (PET) etc., was used to form heat-resistant protective film [0006].

For claims 15 and 20, it would have been obvious to one of ordinary skill in the art to modify the polyester film of APA with the antistatic coating and adhesive layer of Masuda as set forth above, motivated by the desire to obtain an improved resistance to the adhesion of foreign matter or soil caused by static charge of the conductive substrate.

Response to Arguments

7. Applicants argue at Remarks page 6 that

“even if Masuda teaches an embodiment in which no antistatic coating is present on one side of the polyester film, nothing in paragraph [0044] of Masuda provides a transparent adhesive layer formed on and in contact with one side of the base material film. Specifically, there is no express teaching at paragraph [0044] or elsewhere in Masuda that a transparent adhesive layer is formed on and in contact with one side of the base material film.”

However, when the antistatic coating is applied only on one side of the film, and the hard coat is provided on the static coating as set forth above, it is unseen that how the adhesive layer would not be formed on and in contact with one side of the base film, when Masuda teaches that the adhesive layer is formed on the film side which is on the side opposite from the hard coat of the base film.

Applicants argue at page 7 that

“Masuda is directed to a co-extruded laminated polyester film comprising at least three polyester layers. Masuda at Abstract. The presently claimed invention is completely different from that of Masuda because the presently claimed base material a single-layer film.”

However, except for newly added claim 20, the claimed invention fails to exclude a base film having a multilayered structure. Regarding claim 20, it would have been obvious to one of ordinary skill in the art to modify the APA with the antistatic coating of Masuda on at least one side of the protective film, motivated by the desire to obtain an improved resistance to the adhesion of foreign matter or soil caused by static charge of the conductive substrate.

Applicants' arguments directed to withdrawn grounds of rejections are moot.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794